

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Claims 1 and 21 are amended in the present Response to Office Action. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(e)

In paragraph 4 of the Office Action, the Examiner rejects claims 1-3, 5-23, and 25-42 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,708,273 to Ober et al. (hereafter Ober). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Ober fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 21. For example, claim 1 is now amended to recite “said DMA engine including an encryption module that utilizes command information from said encryption structure and control information from said control registers for processing source data to produce destination data during said data encryption operation” (emphasis added), which are limitations that are not

taught or suggested either by the cited reference, or by the Examiner's citations thereto.

Ober teaches a "cryptographic coprocessor" that can be substituted for a current processor to add encryption capabilities (see column 2, lines 33-65). In the rejections of claims 1 and 21, the Examiner cites column 2, lines 19-48 of Ober against Applicants' claimed "creating an encryption structure in a memory device by utilizing a processor." Applicants submit that column 2, lines 19-48 of Ober fails to disclose a processor creating an encryption structure, as recited in claims 1 and 21.

In addition, the Examiner cites column 4, lines 46-60 of Ober against Applicants' claimed "DMA engine." Applicants submit that Ober nowhere teaches or suggests a "DMA engine including an encryption module," as recited in claim 1. On the contrary, Ober explicitly teaches a "standard direct memory access (DMA) controller circuit" (column 4, line 52). In FIG. 1, Ober clearly shows a "DMA controller" that is separate from the "security blocks" that perform encryption procedures (see column 4, lines 46-61). For at least the foregoing reasons, Applicants submit that claims 1 and 21 are not anticipated by the teachings of Ober.

With regard to claim 41, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 41. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 41, should be construed in

light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Ober and Applicants' invention as disclosed in the Specification, claim 41 is therefore not anticipated or made obvious by the teachings of Ober.

Regarding the Examiner's rejection of dependent claims 2-3, 5-20, 22-23, and 25-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-3, 5-20, 22-23, and 25-40 so that these claims may issue in a timely manner.

In addition, with regard to the rejections of claims 8 and 28, the Examiner cites column 25, lines 35-41 of Ober against various elements of Applicants' claimed "command structure". Applicants submit that column 25, lines 35-41 of Ober fails to disclose a "next command structure pointer" or a "control status command", as recited in claims 8 and 28.

In the rejections of claims 9 and 29, the Examiner cites "tables 1 & 2, as well as claim 1" of Ober against various elements of Applicants' claimed "control status command". Applicants find no mention of the claimed elements of their "control status command" in either claim 1 or in tables 1 & 2 of Ober. Applicants

therefore respectfully request the Examiner to explicitly associate the claimed elements of claims 9 and 29 to specific teaching in Ober, or alternatively, to withdraw the rejections of claims 9 and 29 under 35 U.S.C. 102.

With regard to the rejections of claims 10 and 30, the Examiner cites column 5, line 41 through column 6, line 33 of Ober against Applicants' claimed "series of command structures that are linked together in a linked list to thereby perform a series of data encryption operations." Applicants submit that column 5, line 41 through column 6, line 33 of Ober fails to disclose command structures that are linked together in a linked list, as recited in claims 10 and 30.

Regarding the rejections of claims 11 and 31, Ober teaches only a "standard direct memory access (DMA) controller circuit" (column 4, line 52). Ober therefore fails to disclose that "said DMA engine includes a state machine for controlling said data encryption operation, one or more command registers for locally storing one or more command structures from said encryption structure, said control registers, a data buffer, an encryption key register, and said encryption module," as recited by Applicants in claims 11 and 31.

In the rejections of claims 12 and 32, the Examiner cites "tables 1 & 2, as well as claim 1" of Ober against various elements of Applicants' claimed "control registers". Applicants find no mention of the claimed elements of their "control status command" in either claim 1 or in tables 1 & 2 of Ober. Applicants therefore respectfully request the Examiner to explicitly associate the claimed elements of claims 12 and 32 to specific teaching in Ober, or alternatively, to withdraw the rejections of claims 12 and 32 under 35 U.S.C. 102.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Ober to identically teach the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-3, 5-23, and 25-40 may issue in a timely manner.

35 U.S.C. § 103

In paragraph 6 of the Office Action, the Examiner rejects claims 4 and 24 under 35 U.S.C. § 103 as being unpatentable over Ober in view of U.S. Patent No. 6,820,203 to Okaue et al. (hereafter Okaue). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Ober according to the teachings of Okaue would produce the claimed invention. Applicants submit that Ober in combination with Okaue fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Ober nor Okaue contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 4 and 24, for at least the reasons that these claims are indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 4 and 24 so that these claims may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that the cited references do not suggest a combination that would result in Applicants' invention, and therefore the obviousness rejection under 35 U.S.C §103 is improper.

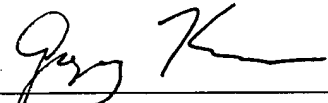
For at least the foregoing reasons, the Applicants submit that claims 4 and 24 are not unpatentable under 35 U.S.C. § 103 over Ober in view of Okaue, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 4 and 24 under 35 U.S.C. § 103.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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